

## REMARKS

In view of the above amendments and the following remarks, reconsideration of the outstanding office action is respectfully requested.

The rejection of claims 41-47, 49-54, 58-73, 75-77, and 80-85 under 35 U.S.C. § 112 (1st para.) for failure to satisfy the written descriptive support for the phrase “promoter that is not pathogen-inducible” is respectfully traversed.

As noted in applicants’ November 3, 2003, Amendment (at page 7), support for the above-recited phrase appears in the description of the invention at page 36, lines 17-21, which recites: “As is conventional in the art, such transgenic plants would contain suitable vectors with *various promoters* including pathogen-induced promoters, and other components needed for transformation, transcription, and, possibly, translation” (emphasis added). The U.S. Patent and Trademark Office (“USPTO”) has interpreted this portion of the specification to support the view that, “at the time of filing, the only promoters contemplated were pathogen-induced promoters or promoters in general, which included pathogen-induced ones” (page 3 of the October 29, 2004, Office Action). Applicants respectfully disagree. One of ordinary skill in the art would understand the above-recited disclosure (i.e., page 36, lines 17-21) to contemplate the use of various promoters, an example of which is pathogen-inducible promoters. The present invention, therefore, also contemplates the use of non-inducible promoters (i.e., constitutive promoters). At the time of filing the present application, one of ordinary skill in the art was well aware of various constitutive promoters used for inducing expression of transgenes in plants. Such constitutive promoters include the nopaline synthase (“NOS”) gene promoter from *Agrobacterium tumefaciens* (U.S. Patent No. 5,034,322 to Rogers et al., issued on July 23, 1991) and the cauliflower mosaic virus (“CaMV”) 35S and 19S promoters (U.S. Patent No. 5,352,605 to Fraley et al., issued on October 4, 1994). Therefore, the skilled artisan would have understood the above-recited language to support the use of such non-inducible promoters. This view is supported by the experimental data and literature described in the Declaration of Zhong-Min Wei Under 37 C.F.R. § 1.132 (“Wei Declaration”), dated August 11, 2004, and submitted herein on August 13, 2004. For example, paragraphs 26-27 of the Wei Declaration describe using the constitutive NOS promoter (i.e., a non-pathogen-inducible promoter) in an *hrpN* transformation construct. As indicated in the Wei Declaration (at paragraph 26), the NOS promoter was well known in the art at the time of filing, having been described in Koncz et al., “The Opine Synthase Genes Carried by Ti Plasmids Contain All Signals Necessary for

Expression in Plants," *EMBO J.* 2(9):1597-1603 (1983) (attached as Exhibit 17 to the Wei Declaration).

For the foregoing reasons, applicants respectfully submit that the instant invention was described in a manner which would convey to one skilled in the art that applicants had possession of the claimed invention at the time they filed the present application. Therefore, the rejection of claims 41-47, 49-54, 58-73, 75-77, and 80-85 for containing new matter is improper and should be withdrawn.

The rejection of claims 41-47, 49-54, 58-73, and 75-77 under 35 U.S.C. § 112 (1st para.) for lack of an adequate written description is respectfully traversed in view of the above amendments.

The rejection of claims 41-47, 49-54, 58-73, and 75-77 under 35 U.S.C. § 112 (1st para.) for lack of enablement is respectfully traversed in view of the above amendments.

The rejection of claims 52 and 72 under 35 U.S.C. § 112 (2nd para.) for indefiniteness is rendered moot in view of the cancellation of these claims.

In view of all of the foregoing, applicants submit that this case is in condition for allowance and such allowance is earnestly solicited.

Respectfully submitted,



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